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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/918,117 | 07/30/2001 | Akira Tsubouchi | 18733/00060 | 2600 |

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EXAMINER

VAN PELT, BRADLEY J

ART UNIT PAPER NUMBER

3682

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,117

Applicant(s)

TSUBOUCHI ET AL.

Examiner

Bradley J Van Pelt

Art Unit

3682

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oya (JP 11-278287) in view of Urschel (USPN 1,983,584).

Oya discloses a hollow rack shaft (fig. A), which is formed by bending a plate so that the two sides of the plate are joined and in a part of the surface of which a row of rack teeth along a direction of the axis is formed.

Oya does not disclose that the rack shaft is provided with a first area and second areas on both sides of it, and in said two second areas, a complete cylindrical part is formed and at least one of the second areas has a diameter different from the diameter of the semi-cylindrical part in said first area, the diameter of at least one of said second areas is smaller than the diameter of said first area.

Urschel renders obvious a hollow shaft in (fig. 20) that is provided with a first area (88) and a second areas (4,40) on both sides of it; and in said two second areas, a complete cylindrical part is formed and at least one of the second areas has a diameter different from the diameter of the cylindrical part in said first area.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus of Oya to alter the areas of the rack shaft for the purpose of reducing the mass of the shaft.

Regarding claim 13, applicant is reminded that although the product by process claim is permissible the process in which the product is made cannot be given patentable weight in a product claim. Therefore, since the limitation of "formed cylindrically by bending a substantially rectangular plate so that the two parallel sides are joined" is not given patentable weight, the rack of that of Oya is deemed fully to meet the instantly claimed invention. In other words, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. The product or article in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product or article was made by a different process. See *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

3. Applicant's arguments filed January 21, 2004 have been fully considered but they are not persuasive. Applicant argues that the rejection of claim 13 over Oya in view of Urschel under U.S.C. § 103(a) is not proper. Specifically, even if Oya and Urschel are combined, the combined teaching would not suggest the limitations of claim 13.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, reducing the mass is proper motivation in combining the references. Furthermore, one with ordinary skill in the art would provide the teeth on either the first or second area to accommodate idiosyncrasies of tooth racks.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley J Van Pelt whose telephone number is 703.305.8176. The examiner can normally be reached on M-Th 7:00-4:30, 2nd F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.2168.

BJVP



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